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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,983	10/17/2000	Jeff S. Eder		2397

29051 7590 06/15/2004

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MILL CREEK, WA 98012

EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/688,983

Applicant(s)

EDER, JEFF S.

Examiner

Harish T Dass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 92-132 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 92-132 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-91 are canceled.

Paper # 10 "Supplemental Amendment" have been considered but it is noted that no new IDS is filed with this paper.

Specification

1. The amendment filed 3/16/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. Inventor substantially has altered original specification and major portion of original specification has been deleted and has added numerous new materials, which are not supported by the original disclosure. For example: page 9 lines 15, 17 & 23 "... the impact of each", "using a series of models", "market value", "net value impact", etc. Examiner has not found the closest relevant paragraph pages showing these changes. See MPEP Paragraph 2163.02.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 98-106 and 122-132 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independent claim 98 and its dependent claim # 99 are vague.

3. Claims 107-121 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material which is not supported by the original disclosure is as follows: page 33, claim 107 line # 4 "common xml" Examiner has not found the closest relevant paragraph pages to showing this change. The office action references to the specification as new matters remove the added limitations or amend to read per original specification. The amended limitation cannot add new matters, which are not in original specification, and applicant should clearly point out where these limitations are referenced.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 92-132 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The metes and bounds of claims are vague and indefinite. More specifically it is not clear how data is being used and what "a variety of systems" include. Further, there are numerous places with informalities and lack of antecedent basis, e.g., "the optimal mix" do not have proper antecedent basis, same for other claims. Applicant is required to fix all proper antecedent basis for limitation which are lacking, especially, since the specification is substantially has been changed and new claims are added.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 107-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ching (US 6,078,901).

Re. Claim 107, Ching discloses quantifying organization risk by element of value using at least a portion of the data [C4 L66 to C5 L40], displaying the quantified risks using a paper document or electronic display [Figure 15-16, 18; C13 L21 to C18 L50; C20 L3-

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L5; C29 L9-L61]. Ching does not explicitly disclose integrating organization related data using a common xml schema.

However, XML and is well known and used and used with web-pages with dynamic data input. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Ching and organize data using XML to allow dynamically inputting and displaying the data.

Re. Claim 108, Ching discloses calculating the amount of capital available for risk reduction purchases [C11 L15-L30], identifying the optimal mix of risk reduction products and risk reduction activities given the quantified risks and available capital (Optimal Resource Allocation) [C11 L15-L30; C13 L20 to C18 L50], and displaying the optimal mix using a paper document or electronic display [Figure 15-16, 18; C13 L21 to C18 L50; C20 L3-L5; C29 L9-L61].

Re. Claim 109, Ching discloses implementing the optimal mix of risk reduction products and risk reduction activities in an automated fashion (Optimal Resource Allocation and Completely Automated And Self-generating Software System) [C3 L3-L4; C11 L15-L30; C13 L20 to C18 L50].

Claims 92-106 and 122-132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ching in view of Donner (US 6,263,314).

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Re. Claims 92 and 122, Ching disclose related computing devices and computer software for price and value determination and for rational decision making based on valuation [see entire document particularly, Abstract; figures 3, 5, 9, 11-12, 15-16, 18-19, 23; C1 L1 to C3 L28; C4 L43 to C5 L38; C23 L17 to C24 L31; C9 L66 to C12 L6; C8 L11-L32; C13 L22 to C18 L50; C39 L50 to C40 L30] and (a) processing means for processing data [C23 L21-L30; C24 L19-L31], (c) first means for obtaining data related to the value of the business, the business having one or more tangible elements of value and intangible elements of value contributing to the value of the business, and the value of the business including a current operation category of value, a real option category of value and a market sentiment category of value [Fig. 18-20; C21 L66-L67; C25 L39-L46; C29 L13-L61], (d) second means for calculating, for each one of the tangible elements of value and intangible elements of value, a tangible measure characterizing the impact of the element of value, second means including means for calculating performance indicators and combining variables, performance indicators and combinations of variables and indicators to calculate the measure (balance sheet, evaluation) [C13 L21 to C18 L50; C29 L13-L61], (e) third means for calculating the value of the current operation, real option and market sentiment categories of the value of the business (present value), (f) fourth means for using the tangible measures to determine, for each one of the elements of value, a percentage of the current operation category contributed by the element of value, a percentage of the real option category contributed by the element of value and a percentage of the market sentiment category contributed by the element of value, and (g) fifth means for calculating a value for each

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of the elements of value based on the current operation, real option and market sentiment categories of value of the business and the percentages of the current operation, real option and market sentiment contributed by the elements of value [Fig. 18-20, C4 L66 to C5 L40; C13 L21 to C18 L50], (h) sixth means for quantifying risks facing the business [C4 L66 to C5 L40], (i) seventh means for relating said risks to the tangible elements of value and intangible elements of value, j) eighth means for quantifying the business impact of said risks using the previously identified relationship between the elements of value and the categories of business value [C13 L21 to C18 L50; C20 L3-L5; C29 L9-L61] and (k) ninth means for displaying the values and quantified risk impacts by element [Figure 15-16, 18; C13 L21 to C18 L50; C20 L3-L5; C29 L9-L61] and measures of element of value impact on aspects of organization financial performance using aggregated organization related data and uses the measures to create tools for financial performance management [Fig. 11-12 C21 L66-L67; C25 L39-L46; C29 L13-L61; C13 L21 to C18 L50]. Ching, explicitly, does not disclose (b) storage means for storing data. However, Donner discloses an intellectual property audit systems, which collects pertinent data regarding an intellectual property portfolio and analyzes the collected data against empirical data to provide a qualitative and/or quantitative analysis of the intellectual property portfolio, and storage means for storing data [Abstract; Figures 8-9; C7 L30 to C8 L7; C10 L53 to C35] to store empirical data and database. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine the teaching of Ching and Donner and include analysis of intellectual property by collecting pertinent data regarding an

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intellectual property portfolio and analyzes the collected data against empirical data to provide a qualitative and/or quantitative analysis of the intellectual property portfolio and storing collected data to storage device for further use. Further, it is well known to one skill in the art of pharmaceutical industry such as Merk Inc. to report all it tangible and intangible assets in their balance sheet for accurate calculation where these evaluations are useful in merger and acquisitions of companies.

Re. Claims 93-95, Ching discloses where the risks quantified by the sixth means are generic risks, contingent liabilities and combinations thereof, identifying the one or more tangible indicators included in the measures associated with each element of value that are affected by each risk, quantifying the change in the measure caused by the change in the one or more tangible indicators included in each element of value measure, and using the established relationships between element measures and the categories of value to quantify the business impact by element of value [Figures 15-20; C4 L66 to C5 L40; C9 L66 to C11 L65]

Re. Claim 96, Ching discloses wherein said ninth means further comprises a paper document, electronic display or combination thereof [Figure 15-16, 18; C13 L21 to C18 L50; C20 L3-L5; C29 L9-L61.

Re. Claim 97, Ching does not explicitly disclose means for identifying the optimal risk transfer purchase for the business. However, this step is well known and used for

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evaluation of corporations during mergers and acquisitions on their balance sheet to show the assets and liabilities, insurance and future payments and expected losses. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Ching and include identifying the optimal risk transfer purchase for the business to justify the purchase decision.

Claims 98-106 are rejected with same rational as claims 92-97 and are rejected likewise.

Re. Claims 123-128, 130-132 Ching discloses wherein the organization comprises a single product, a group of products, a division or a company, a multi-enterprise organization or a value chain, where the aspects of financial performance are selected from the group consisting of revenue, expense, capital change, real option value, market value and combinations thereof, where the elements of value are selected from the group consisting of alliances, brands, channels, customers, customer relationships, employees, intellectual property, partnerships, processes, production equipment, vendors, vendor relationships and combinations thereof [see entire document particularly, C21 L66-L67; C25 L39-L46; C29 L13-L61; C13 L21 to C18 L50], where the tools for financial performance management are selected from the group consisting of a network model that quantifies net element impact on organization value, a network model that quantifies net element impact on organization revenue, a network model that quantifies net element impact on organization expense, a network model that quantifies

net element impact on organization capital change, a model that quantifies net element impact on organization real option value, a network model that quantifies net element impact on organization market sentiment, a simulation model that quantifies the impact of risks on organization value by element of value, a simulation model that quantifies the impact of risks on organization revenue by element of value, a simulation model that quantifies the impact of risks on organization expense by element of value, a simulation model that quantifies the impact of risks on organization capital change by element of value, a simulation model that quantifies the impact of risks on organization real options by element of value a simulation model that quantifies the impact of risks on organization market sentiment value by element of value and combinations thereof [C2 L57 to C3 L4; C4 L43 to C5 L38; C9 L66 to C12 L6; C8 L11-L32; C13 L22 to C18 L50; C39 L50 to C40 L30], where the models support activities from the group consisting of optimization of one or more aspects of organization financial performance, financial simulations, element valuations, risk quantification, management reporting and combinations thereof where the models are developed in an automated fashion, where the elements of value are selected from the group consisting of alliances, brands, channels, customers, customer relationships, employees, intellectual property, partnerships, processes, production equipment, vendors, vendor relationships and combinations thereof, where the element of value impact on aspects of organization financial performance is the direct impact on an aspect of financial performance net of any impact on other elements of value

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[see entire document particularly, C21 L66-L67; C25 L39-L46; C29 L13-L61; C13 L21 to C18 L50].

Re. Claims 129 and 132, Ching explicitly does not disclose where the risks are from the group consisting of fire risks, earthquake risks, flood risks, weather risks, contingent liabilities and combinations thereof and further comprises networked computers each with a processor having circuitry to execute instructions where each processor has a storage device that is available to it and each storage device has sequences of instructions stored therein which when executed cause the processors to complete the required processing. However, these are well known and obvious step in insurance industries and Internet search computers. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify teaching of Ching and include of generic risk and contingent liabilities to evaluate real estate risk component related to these group (fire, earthquakes, floods, weather, etc.) which affect the insurance policy.

Claims 110-121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ching as applied to claim 107 above, in view of Donner.

Re. Claims 110-121, Ching discloses where organization related data is obtained from the group consisting of advanced financial systems, basic financial systems, web site management systems, alliance management systems, brand management systems,

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customer relationship management systems, channel management systems, intellectual property management systems, process management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, capital asset systems, inventory systems, invoicing systems, payroll systems, enterprise resource planning systems (ERP), material requirement planning systems (MRP), scheduling systems, quality control systems, purchasing systems, the Internet, external databases, user input and combinations thereof [Abstract; C2 L57 to C3 L4; C4 L43 to C5 L38; C9 L66 to C12 L6; C8 L11-L32; C13 L22 to C18 L50; C39 L50 to C40 L30], wherein the organization comprises an enterprise, a multi-enterprise organization or a value chain, wherein an enterprise comprises a single product, a group of products, a division or a company, where the elements of value are selected from the group consisting of alliances, brands, channels, customers, customer relationships, employees, intellectual property, partnerships, processes, production equipment, vendors, vendor relationships and combinations thereof, where the risks are from the group consisting of fire risks, earthquake risks, flood risks, weather risks, contingent liabilities and combinations thereof, wherein the risks are quantified under scenarios from the group consisting of normal, extreme and combinations thereof, where quantifying risks by element of value further comprises, identifying tangible measures for each element of value that incorporate one or more tangible indicators of element impact, quantifying the relationship between elements of value and the categories of value using said tangible measures, quantifying organization risks, identifying the one or

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more tangible indicators included in the measures associated with each element of value that are affected by each risk, quantifying the change in the measure caused by the risk induced change in the one or more tangible indicators included in each element of value measure, and using the established relationships between element measures and the categories of value to quantify the business impact by element of value, wherein the quantified risks by element of value are further identified by category of value where the categories of value are current operation, real options and market sentiment, where the risk transfer products are insurance or derivatives, where the optimal mix is determined using a multi-criteria optimization for a combined normal and extreme scenario, where implementing the optimal mix of risk reduction products and risk reduction activities further comprises: completing the purchase of risk transfer products in an automated fashion, and identifying changes in operating limits by organization system [C2 L57 to C3 L4; C4 L43 to C5 L38; C9 L66 to C12 L6; C8 L11-L32; C13 L22 to C18 L50; C39 L50 to C40 L30], and communicating the changes in operating limits to organization systems, where organization systems are selected from the group consisting of advanced financial systems, basic financial systems, alliance management systems, brand management systems, customer relationship management systems, channel management systems, intellectual property management systems, process management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, capital asset systems, inventory systems, invoicing systems, payroll systems, enterprise resource

planning systems (ERP), material requirement planning systems (MRP), scheduling systems, quality control systems and purchasing systems and combinations thereof [C2 L57 to C3 L4; C4 L43 to C5 L38; C9 L66 to C12 L6; C8 L11-L32; C13 L22 to C18 L50; C39 L50 to C40 L30]. Ching, explicitly, does not disclose intangible elements (intellectual properties). However, Donner discloses this item [see entire document particularly, Abstract, Figures]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine the teaching of Ching and Donner and include analysis of intellectual property by collecting pertinent data regarding an intellectual property portfolio and analyzes the collected data against empirical data to provide a qualitative and/or quantitative analysis of the intellectual property portfolio.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628

6/14/04


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